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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/071,377 | 02/07/2002 | Timothy B. Karpishin | 269/003 | 1762 |

25226 7590 01/23/2004

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EXAMINER

COLEMAN, BRENDA LIBBY

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1624

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,377

Applicant(s)

KARPISHIN ET AL.

Examiner

Brenda L. Coleman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Claims 1-49 are pending in the application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, 10, 13-19, 20-22 and 42-45, drawn to the amphiphilic module consisting of 8 synthons where 4 are phenyl rings and 4 are cyclohexyl rings.
- II. Claims 1-7, 10, 13-16, 20-22 and 42-45, drawn to the amphiphilic module consisting of 8 synthons where 4 are phenyl rings and 4 are piperidyl rings.
- III. Claims 1-7, 10, 13-16, 23-25 and 42-45, drawn to the amphiphilic module consisting of 8 synthons where 4 are phenyl rings and 4 are bicyclo[2.2.1]heptyl rings.
- IV. Claims 1-7, 11, 26-32, 36-38 and 42-45, drawn to the amphiphilic module consisting of 6 synthons where 3 are phenyl rings and 3 are cyclohexyl rings.
- V. Claims 1-7, 11, 26-29, 33-35 and 39-45, drawn to the amphiphilic module consisting of 6 synthons where 3 are phenyl rings and 3 are bicyclo[2.2.1]heptyl rings.
- VI. Claims 1-8 and 42-45, drawn to the amphiphilic module consisting of 12 synthons.

- VII. Claims 1-7, 9 and 42-45, drawn to the amphiphilic module consisting of 10 synthons.
- VIII. Claims 1-7, 12 and 42-45, drawn to the amphiphilic module consisting of 4 synthons.
- IX. Claims 46-49, drawn to two a dimensional array.

The inventions are distinct, each from the other because of the following reasons:

Groups I-IX are directed to structurally dissimilar compounds such that the variable core created by the varying definitions of the synthons, lipophilic moieties and hydrophilic moieties do not belong to a recognized class of chemical compounds in the art, and references anticipating one invention, would not render obvious the others, for example a module with 6 synthons is different from a module with 8 synthons, 10 synthons, etc. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One skilled in the art would not consider such diverse structures as functional equivalents of each other. The mere fact that there is a single similarity is not in itself a significant reason to render the whole embodiment obvious.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the

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prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Tentative election of a single species within the elected group is further required.

It may be necessary upon further review of any of Groups I-IX, for an additional restriction, which may be required by the examiner.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 703-305-1880. The examiner can normally be reached on 8:30-5:00 Monday - Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Brenda Coleman
Primary Examiner Art Unit 1624
January 16, 2004